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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,666	10/29/2003	Susumu Yamada	S008-P03193US	6837
33356	7590	07/07/2005	EXAMINER	
SoCAL IP LAW GROUP LLP 310 N. WESTLAKE BLVD. STE 120 WESTLAKE VILLAGE, CA 91362				TIBBITS, PIA FLORENCE
ART UNIT		PAPER NUMBER		
2838				

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/696,666	YAMADA ET AL.
	Examiner Pia F. Tibbits	Art Unit 2838

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/17/2005</u>	.5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claim 1 is objected to because of the following informalities: "chargeable charger" should be corrected; "chargeable charger information" lacks antecedence. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-9: the use of "or" throughout the claims make the claim language confusing because it is not clear what applicant is actually claiming. Furthermore, applicant is reminded that "or" should only be used with alternate terms, e.g., rod or bars, etc.

5. The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors.

Claim 1: "battery management information is at least either available device information on a device" should be clarified. To continue prosecution it was assumed that the batteries provide battery-state data via a bus to a host computer included in a device.

Claim 2: "discharged device history information" is incorrect since the discharging battery **powers** the device. To continue prosecution it was assumed that the battery provides charge/discharge current information.

Claim 6: "discharged device history information" is recited, while the specification describes "when the battery 100 is loaded anew into a device 200, the device 200 reads the battery management data of the discharged device history information from the memory 130 of the battery 100". To continue prosecution it was assumed the device may communicate with the battery and request information from the battery for use in the system power management scheme, thereby providing the user of the host device with information about the battery's present state and capabilities.

The above are but a few specific examples of indefinite and functional or operational language used throughout the claims, and are only intended to illustrate the extensive revision required to overcome the rejections under 35 USC 112, second paragraph. The above-mentioned corrections therefore, are in no way a complete and thorough listing of every indefinite and functional or operational language used throughout the claims. Applicant is required to revise all of the claims completely, and not just correct the indefinite and functional or operational language mentioned. The following art rejections are given in view of the above rejections of claims under 35 USC 112, second paragraph. Therefore, the following art rejections are applied only as far as the claims are understood in view of rejections made under the second paragraph of 35 USC 112.

Art Rejection Rationale

6. At the outset, the examiner notes that claims are to be given their broadest reasonable interpretation in light of the supporting disclosure. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ 2d 1320, 1322 (Fed. Cir. 1989); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969); *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984); *Burlington Indus. V. Quigg*, 822 F.2d 1581, 3 USPQ 2d 1436 (Fed. Cir. 1987); *In re Morris*, 43 USPQ 2d 1753, 1756 (Fed. Cir. 1997). ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this

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way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). In responding to this Office action, applicants are reminded of the requirements of 37 CFR 1.111 and 1.119 that applicants specifically point out the specific distinctions believed to render the claims patentable over the references in presenting responsive arguments. See MPEP 714.02. The support of any amendments made should also be specifically pointed out. See MPEP 2163.06.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by **Shyr et al.**[hereinafter Shyr][5903764] and **Smart Battery Data Specification** at <http://www.sbs-forum.org/specs/sbdat110.pdf>.

Shyr discloses in figures 1-12 a "smart" battery 22a comprising a storage section for storing battery management information transmitted/received to/from outside through a communicator 62; wherein, said battery management information is providing battery-state data via a bus to a host computer 32 included in a device [see column 1, lines 11-14], which can use said battery or charger information for a charger 26 which can charge said battery [see column 1, lines 30-44; column 3, lines 25-39; column 6, lines 35-53].

The secondary reference is only used to explain the meaning of a term used in the primary reference, according to MPEP 2131.01, Multiple Reference 35 U.S.C. 102 Rejections, "when the claimed limitation is disclosed identically by the reference, an additional reference may be relied on to show that the primary reference has an "enabled disclosure." *In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

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Smart Battery Data Specification discloses that a "smart" battery is a microprocessor controlled rechargeable battery that communicates factual data such as battery identification data, temperature, voltage, charge/discharge current and existing state of charge to a host computer device or smart battery charger via a System Management Bus by using a System Management Bus BIOS Interface Specification.

With regard to the limitation of having a storage section/memory for the battery: it is an inherent function of the "smart" battery to include a memory, and MPEP 2100 states that the disclosure of a limitation may be expressed, implicit or **inherent**.

9. Claims 2-5 are rejected under 35 U.S.C. 102(b) as being anticipated by **Shyr**, as described above, and **Smart Battery Charger Specification** at <http://www.sbs-forum.org/specs/sbc100.pdf>.

Shyr discloses a "smart" battery 22a comprising a storage section for storing battery management information transmitted/received to/from outside through a communicator; wherein, said battery management information is at least charge/discharge current information.

Smart Battery Charger Specification discloses a smart battery would tell the charger how to adjust the charging cycle based on its current state of discharge, current temperature, charge/discharge cycle count to date, and other relevant data. Optionally, if a battery didn't control its own charging, the "smart" charger would request the battery chemistry, manufactured capacity, and related data and then choose an optimal charging algorithm based on this information.

As to claims 3-5, see remarks and references above.

10. Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by **Hull et al.** [hereinafter Hull][5606242].

Hull discloses in figures 1-20B a device 16 into which a "smart" battery 10 discharges, the battery having a storage section 65 and 67 [see fig.2B] for storing battery management information transmitted/received to/from outside through a communicator 14 [see fig.1], wherein host device 16 may communicate with the smart battery over the system management bus 14 and request information from

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the battery for use in the system power management scheme, thereby providing the user of the host device with information about the battery's present state and capabilities [see abstract].

As to claim 7, see remarks and references above.

As to claim 8, Hull discloses in fig.9 a logic flow diagram of the handle request routine that is invoked when there is communication between the smart battery and the host computer or battery charger.

As to claim 9, see remarks and references above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited in PTO-892 and not mentioned above disclose related apparatus: **Mann et al.**

[5754029], **Kumar et al.** [6018227] [6160376][6331761] disclose a charger and a complementary battery pack that, collectively, provide information about the charge state and history of the battery pack.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Pia Tibbits whose telephone number is (571) 272-2086. If unavailable, contact the Supervisory Patent Examiner Mike Sherry whose telephone number is (571) 272-2084. The Technology Center Fax number is (703) 872-9306.

3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PFT

July 5, 2005

Pia Tibbits

Primary Patent Examiner